



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,683	12/05/2003	Michael J. Gauer	14012-054001/50-03-047	9079

26230 7590 02/05/2008
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

THOMAS, ASHISH

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

02/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/728,683	Applicant(s) GAUER, MICHAEL J.	
	Examiner Ashish K. Thomas	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/5/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 21-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regards to claims 21-29, these claims describe an "article." But the claim language is not definite in what actually constitutes an "article." In view of this, the "article" claimed in the claim language could be a computer program, thereby rendering it as non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phang(U.S. 6,437,876) in view of Ochiai(U.S. 2003/0112462).

Regarding claim 33, Phang describes a method comprising: receiving document data for printing a document from an application, wherein the document data comprises data relating to content and format of a document(**Column 3, line 58-column 4, line 10**

teaches that a print job is received. Note that content and formatting data is inherently taught by the existence of a print job.); formatting a page to be printed such that the page comprises at least a portion of the received document data and other information, and the other information is located between document margins and printer allowable margins(**Column 1, lines 40-54 describes a well known method wherein other information such as headers are printed in an area outside of the work area. Note that the “work area” described in the reference reads on document margin, and area outside the “work area” reads on printer allowable margin);** checking whether information for the formatted page fits between the document margins and the printer allowable margins(**Column 1, lines 60-67 details a method that checks if data is within the allowed printable margins.);** initiating an alert if the information for the formatted page does not fit between the document margins and the printer allowable margins(**Column 2, lines 23-33 describes a method that warns the user if the data cannot be incorporated into the printable margin.);** generating a user interface that allows formatting of content, location, orientation, and appearance of information(**Column 5, lines 38-54 details a user interface that allows the user to make formatting changes to the document.);** and generating a message comprising the formatted page(**column 8, lines 45-55).**

But Phang is silent on a method that determines an identifier associated with a sender of document data, and accessing information associated with the sender identifier, including querying a database comprising sender associated information.

Ochiai, on the other hand, teaches a method that determines an identifier associated with a sender of document data(**Paragraphs 22 and 23 discuss a user ID.**), and accessing information associated with the sender identifier, including querying a database comprising sender associated information(**Paragraphs 31-33 detail a method that accesses stored user identifying information; this reads on the concept of querying a database.**).

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Phang with Ochiai to fully realize the method stated in claim 33.

The motivation can be to put forth a method that enables one to view identification information of a certain print job, as stated in paragraph 8 of the Ochiai reference.

Regarding claim 1, it is rejected in the same manner as claim 33. Note that claim 1 merely cites a broader version of the method cited in claim 33. For this reason, the rejection of claim 33 can be properly used in rejecting claim 1.

Regarding claim 14, it is rejected in the same manner as claim 33. Note that claim 14 merely cites a system that corresponds to the some of the subject matter claimed in claim 33. For this reason, the rejection of claim 33 can be properly used in rejecting claim 14.

Regarding claim 21, it is rejected in the same manner as claim 33. Note that claim 21 merely cites a machine readable medium that stores instructions that

correspond to the some of the subject matter claimed in claim 33. For this reason, the rejection of claim 33 can be properly used in rejecting claim 21.

Regarding claim 30, it is rejected in the same manner as claim 33. Note that claim 30 merely cites a system that corresponds to the some of the subject matter claimed in claim 33. For this reason, the rejection of claim 33 can be properly used in rejecting claim 30.

Regarding claim 2, the combination of Phang and Ochiai teaches the method stated in claim 1. Furthermore, Phang teaches receiving a request to format information associated with a sender of document data(**Column 3, line 59-column 4, line 10 teaches that a print document is received.**); and generating a user interface that allows formatting of information associated with a sender of document data(**Column 5, lines 38-55 mentions a user interface that allows a user to change formatting information.**).

Regarding claims 18 and 22, they are rejected in the same manner as claim 2. Note that claim 18 divulges a system and claim 22 divulges a computer readable medium storing instructions, both corresponding to the method claimed in claim 2.

Regarding claim 3, the combination of Phang and Ochiai teaches the method of claim 2. Furthermore, Phang discloses that the user interface allows specification of the orientation of information associated with a sender of document data. (**Column 5, lines 49-55 teaches the ability to set the margins. Using the broadest reasonable interpretation of the claim language, this reads on the orientation information.**)

Regarding claim 4, the combination of Phang and Ochiai teaches the method of claim 2. In addition, Ochiai teaches that the user interface allows specification of information associated with a sender of document data. **(Paragraphs 21 and 22 teach that user identification information are set. This inherently teaches the existence of a user interface that enables a user to set such type of information.)**

Regarding claim 5, the combination of Phang and Ochiai teaches the method of claim 2. In addition Phang discloses that the user interface allows specification of the presentation style of information associated with a sender of document data. **(Column 5, lines 49-55 teaches the ability to set the margins. The change of margins can be interpreted as an example of specifying the presentation style. After all, a change in margins does alter the way in which the print data is presented.)**

Regarding claim 6, the combination of Phang and Ochiai teaches the method of claim 2. Phang further recites that the user interface allows specification of the location of information associated with a sender of document data. **(Column 5, lines 49-55)**

Regarding claim 7, the combination of Phang and Ochiai teaches the method of claim 1. Phang further teaches that formatting a page to be printed comprises checking whether the accessed information for the formatted page fits between the document margins and the printer allowable margins. **(column 1, lines 40-54)**

Regarding claims 20, 24, and 31, they are rejected in the same manner as claim 7. Note that these claims describe a system and computer readable medium with stored instructions, all corresponding to the method claimed in claim 7.

Regarding claim 8, the combination of Phang and Ochiai teaches the method of claim 7. Phang further teaches initiating an alert if the accessed information for the formatted page does not fit between the document margins and the printer allowable margins. **(column 2, lines 23-35)**

Regarding claims 25 and 32, they are rejected in the same manner as claim 8. Note that these claims describe a system and computer readable medium with stored instructions, all corresponding to the method claimed in claim 8.

Regarding claim 9, the combination of Phang and Ochiai teaches the method of claim 8, Phang further puts forth a method comprising allowing the format of the accessed information to be changed. **(column 5, lines 38-55)**

Regarding claim 26, it is rejected in the same manner as claim 9. Note that claim 26 describes a computer readable program that stores instructions which correspond to the method stated in claim 9.

Regarding claim 10, the combination of Phang and Ochiai teaches the method of claim 1. Ochiai further teaches a method comprising associating the received document data with a sender of the document data. **(Paragraphs 22 and 23)**

Regarding claim 27, it is rejected in the same manner as claim 10. Note that claim 27 describes a computer readable program that stores instructions which correspond to the method stated in claim 10.

Regarding claim 11, the combination of Phang and Ochiai teaches the method of claim 10. Ochiai further teaches a method wherein associating the received document data with a sender of the document data comprises determining a sender identifier

accompanying the document data. **(Paragraphs 22 and 23 discuss a method that associates a sender ID with the print job.)**

Regarding claim 12, the combination of Phang and Ochiai teaches the method of claim 1. Furthermore, Ochiai teaches a method wherein accessing information associated with a sender of the document data comprises querying a database comprising sender associated information. **(Paragraphs 31-33)**

Regarding claim 28, it is rejected in the same manner as claim 12. Note that claim 28 describes a computer readable program that stores instructions which correspond to the method stated in claim 12.

Regarding claim 13, the combination of Phang and Ochiai teaches the method of claim 1. In addition, Phang teaches a method that generates a message comprising the formatted page. **(column 8, lines 45-55)**

Regarding claim 29, it is rejected in the same manner as claim 13. Note that claim 29 describes a computer readable program that stores instructions which correspond to the method stated in claim 13.

Regarding claim 15, the combination of Phang and Ochiai teaches the system of claim 14. Phang further teaches a system wherein document data includes data relating to appearance and content of a document. **(Column 3, line 59-column 4, line 10 teaches that a print job is received. The existence of a print job inherently teaches the existence of the document data that relates to both the content and appearance of the document. Note that a print job consists of both the content of the job and the formatting parameters associated with the job.)**

Regarding claim 16, the combination of Phang and Ochiai teaches the system of claim 14. Phang further teaches that the processor is further operable to format document data in relation with formatting requirements associated with a printer. **(Column 5, lines 45-55 describes changing the margins to fit the media on the printer.)**

Regarding claim 17, the combination of Phang and Ochiai teaches the system of claim 14. Phang further teaches that the apparatus comprises a printer driver. **(Column 5, lines 45-55 teaches a printer driver.)**

Regarding claim 19, the combination of Phang and Ochiai teaches the system of claim 18. Phang further teaches a user interface that allows specification of the content and appearance of information associated with a sender of document data. **(Column 5, lines 45-55 also describes an interface that allows the user to change the margins, thereby affecting the content and appearance of the data.)**

Regarding claim 23, it is rejected in the same manner as claim 19. Note that claim 23 describes a computer readable medium that stores a program while claim 19 describes a system. Both claims divulge the same functionalities.

Conclusion

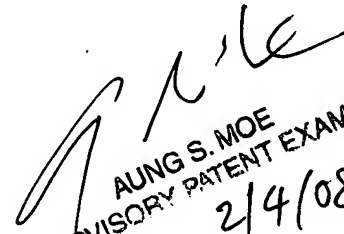
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashish K. Thomas whose telephone number is 571-272-0631. The examiner can normally be reached on 9:00 a.m. - 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung S. Moe can be reached on 571-272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ashish K. Thomas



AUNG S. MOE
SUPERVISORY PATENT EXAMINER
2/4/08